

## **REMARKS**

The following remarks are submitted in response to the Office Action mailed on December 31, 2003. Claims 3, 20-21, 32, 44, 48, 59-60, 75, 98-99, 110, 122, 130 and 150 were withdrawn from consideration. With this Amendment, claims 4, 9, 33, 38, 49, 54, 74-84, 106-117, 123, 129-148 and 151 have been cancelled, and a new claims 164 and 165 have been added. Therefore, claims 1, 2, 4-8, 10-19, 22-31, 33-37, 39-43, 45-47, 49-53, 55-58, 61-73, 85-97, 100-105, 118-121, 123-128, 149 and 151-165 remain pending and under consideration. No new matter has been added. Reconsideration, examination and allowance of the pending claims is respectfully requested.

### **Power of Attorney**

Applicants enclose herewith a Revocation and Power of Attorney form.

### **Amendments to the Specification**

Clarifying amendments have been made to the specification primarily to correct typographical errors. No new matter has been added.

### **Drawing Objections**

In paragraph 3 of the Office Action, the Examiner objects to Figure 23B. The Examiner correctly notes that element number 228 is missing from the figure. Applicants respectfully submit an amended Figure 23B properly identifying missing element number 228.

### **Other Miscellaneous Objections**

In paragraph 4 of the Office Action, the Examiner points out that claim number 122 was missing, and that misnumbered claims 123-164 were renumbered 122-163. Applicants have used the renumbering indicated by the Examiner, and have amended the claims where appropriate to remedy dependency issues that arose due to the renumbering. Additionally, claims 11 and 129 were objected to because of various claim language informalities. Applicants have reviewed and amended the claims to correct the informalities noted by the Examiner.

### **The 35 U.S.C. § 112 Claim Rejections**

In paragraphs 7 of the Office Action, the Examiner rejects claims 40 and 41 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention due to insufficient antecedent basis. Applicants have amended claims 40 and 41 to change their dependency, as suggested by the Examiner. Withdrawal of this rejection is, therefore, respectfully requested.

### **Allowable Subject Matter**

In the Office action, the Examiner indicated that claims 9-10, 18-19, 38-39, 54, 87-89, 93-97, 125 and 153 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent format. Additionally, claims 11 and 15-17 were similarly allowable if rewritten to overcome the minor informality objections. Applicants respectfully thank the Examiner for this indication of allowable subject matter.

### **The 35 U.S.C. § 102 Claim Rejections**

Claims 1-2, 4-5, 12, 22, 25-31, 33-34, 37, 40, 43, 45-47, 49-50, 53, 55, 58, 61-62, 65-68, 71-74, 76-77, 80, 83, 85-86, 90, 100, 103-109, 111-112, 115-121, 123-124, 126-129, 131-132, 135-137, 140-143, 146-149, 151-152, 154-158 and 160-163 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,385,574 to Hauser et al. (hereinafter "Hauser et al."). Claims 74, 76-77, 80, 83, 106-109, 111-112, 115-117, 129, 131-132, 135-137, 140-143 and 146-148 have been canceled, rendering the rejection of these claims moot. With regard to the remaining claims that are rejected under 35 U.S.C. § 102(b), Applicants submit the following remarks.

As an initial matter, independent claims 1, 28, 46 and 164 now include subject matter indicated as being allowable by the Examiner.

Independent claim 1 has been amended to include the recitations of claim 9, which was indicated as allowable by the Examiner. Claim 9 has been cancelled. As such, Applicants submit that independent claim 1 is now allowable over Hauser et al. While claim 9 was originally dependent upon claim 8, Applicants respectfully submit that the recitations of claim 8 are not necessary to make claim 1 allowable over Hauser et al., either alone or in combination

with the other cited art. Additionally, claim 11 has been amended to remedy the minor informalities identified by the Examiner. Applicants respectfully request indication of allowance of independent claim 1. Additionally, dependent claims 2, 4-8, and 10-19, 22-27 depend from claim 1 and are, therefore, allowable for the reasons given and because they include subject matter that further distinguishes them from the art.

Similarly, independent claim 28 has been amended to include the recitations of claim 38, which was indicated as allowable by the Examiner. Claim 38 has been cancelled. As such, Applicants respectfully submit that independent claim 28 is allowable over Hauser et al. Also, dependent claims 29-31, 33-37, 39-43 and 45 depend from claim 28 and are, therefore, allowable for the reasons given and because they include subject matter that further distinguishes them from the art.

Also, independent claim 46 has been amended to include the recitations of claim 54, which was indicated as allowable by the Examiner. Claim 54 has been cancelled. As such, Applicants respectfully submit that independent claim 46 is allowable over Hauser et al. Also, dependent claims 47, 49-53, 55-58 and 61-73 depend from claim 46 and are, therefore, allowable for the reasons given and because they include subject matter that further distinguishes them from the art.

Likewise, new claim 164 includes the recitation that the implantable cardioverter-defibrillator "includes a housing including a first segment and a second segment, each segment having an insulating plate at an end thereof, and a conductive plate coupled to the insulating plate, wherein the conductive plate of the first segment is coupled to the conductive plate of the second segment to form a unitary implantable device." The Examiner indicated that the prior art fails to teach such an ICD. Therefore, it is respectfully submitted that claim 164 is in condition for allowance.

Independent claims 85, 118, and 149 are also allowable over Hauser et al. Each of these claims recites, among other elements, a cardioverter-defibrillator including a housing comprising a mixture of conductive and nonconductive materials. Such a mixture includes both conductive and nonconductive materials within the mixture composition. In other words, the conductive and nonconductive materials would be mixed or otherwise combined to form the mixture.

The Examiner states in the Office Action that “Hauser et al. shows the housing comprises a mixture of ceramic and titanium,” citing column. 6, lines 49-60 of Hauser et al. Applicants respectfully submit that Hauser et al. do not teach a mixture, as claimed. Rather, Hauser et al. teach that some portions of the housing may be conductive or selective surface portions may be insulative. In that regard, Hauser et al. teach that the housing may be titanium, and an insulative ceramic material may be sputtered onto the conductive outer surface of the body. Such an arrangement is not a mixture of conductive and nonconductive materials, but rather, would be a coating of ceramic material disposed over a portion of the titanium housing. As such, Applicants respectfully submit that independent claims 85, 118 and 149 are allowable over Hauser et al. Also, dependent claims 86-97, 100-105; claims 119-121, 123-128; and claims 151-163; which depend from independent claims 85, 118, and 149, respectively, are also allowable for the reasons given and because they include subject matter that further distinguishes them from the art.

#### **The 35 U.S.C. § 103 Claim Rejections**

Claims 6-7, 35-36, 51-52, 78-79, 113-114 and 133-134 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauser et al. in view of U.S. Patent Publication No. 2002/0120296 to Mech et al. (hereinafter “Mech et al.”). Claims 13-14, 41-42, 56-57, 63-64, 81-82, 91-92 and 138-139 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauser et al.. Claims 23-24, 69-70, 84, 101-102, 144-145 and 159 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hauser et al. in view of U.S. Patent No. 5,871,506 to Mower (hereinafter “Mower”). Rejected claims 78-79, 81-82, 84, 113-114, 133-134, 138-139, and 144-145, have been canceled, rendering the obviousness rejection of these claims moot. With regard to the remaining claims that are rejected under 35 U.S.C. § 103(a), Applicants submit the following remarks.

As indicated above, independent claims 1, 28, 46, and 164 now include subject matter indicated as being allowable over the cited art by the Examiner. As such, the claims that depend from these independent claims are also allowable over the cited art. Claims that stand rejected for obviousness but that are dependent on these allowable independent claims include claims 6-7, 13-14, 23-24, 35-36, 41-42, 51-52, 56-57, 63-64 and 69-70. In view of the fact that these claims

are dependent upon independent claims that are now in condition for allowance, reconsideration and withdrawal of the obviousness rejection of these claims is respectfully requested.

Also as discussed above, independent claims 85, 118 and 149 are allowable over Hauser et al. because each of these claims recites a cardioverter-defibrillator including a housing comprising a mixture of conductive and nonconductive materials, and Hauser et al. do not teach or suggest a housing comprising a mixture of conductive and nonconductive materials. As such, each of these claims, and claims which depend there from, are allowable over Hauser et al. Additionally, neither Mech et al. nor Mower resolve the deficiency of Hauser et al. Specifically, neither Mech et al. nor Mower teach or suggest a cardioverter-defibrillator including a housing comprising a mixture of conductive and nonconductive materials. As such, independent claims 85, 118 and 149, and claims which depend there from, are allowable over Hauser et al. alone, or in combination with the other cited references. Claims that stand rejected for obviousness but that are dependent on these allowable independent claims include claims 91-92, and 101-102 (which depend from independent claim 85), and claim 159 (which depends from independent claim 149). In view of the fact that these claims are dependent upon independent claims that are now in condition for allowance, reconsideration and withdrawal of the obviousness rejection of these claims is respectfully requested.

### **The Double Patenting Rejections**

The Examiner indicated that claims 1, 46, 74, 106, and 129 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 51, 81, and 83 of co-pending Application No. 09/940,373. As an initial matter, claims 74, 106, and 129 have been canceled, rendering the provisional rejection of these claims moot. Additionally, 1, 3, 81, and 83 of Application No. 09/940,373 have also been canceled. Therefore, the only issue that remains is remaining claims 1 and 46 being provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 51 of co-pending Application No. 09/940,373.

Applicants respectfully submit that claims 1 and 46, as amended, are patentably distinct from claim 51 of copending Application No. 09/940,373. As such, Applicants respectfully request withdrawal of the provisional obviousness-type double patenting rejection.

**Conclusion**

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Gust H. Bardy et al.

By their Attorney,

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